

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed May 20, 2004 (the "Office Action"). In order to advance prosecution of this case, Applicants amend Claims 30 and 39. Applicants respectfully request reconsideration and favorable action in this case.

**Section 103 Rejections - Bruno**

The Examiner rejects Claims 1-2, 4, 8-9 and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,563,882 issued to Bruno et al. ("*Bruno*"). Applicants respectfully traverse these rejections.

Claim 1 is directed to a method for allocating a plurality of call resources during a conference call and recites "conducting a conference call between three or more clients using a first call resource," "identifying a second call resource available to conduct the conference call" and "transferring the conference call from the first call resource to the second call resource." Claim 21 recites similar elements. The Office Action states that *Bruno* does not teach conducting a conference call between three or more clients. See Office Action, page 2. The Office Action further states that:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to conduct a conference call between two, three, four, ...n of clients, depending on the number of participants in the conference call. Also bridging the clients in a conference call will provide them with the speed and the convenience.

Office Action, page 3. Applicants respectfully disagree.

First, Applicants note that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modifications. See M.P.E.P. § 2143.01. In addition, if the proposed modification would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See M.P.E.P. § 2143.01. *Bruno* is directed to a process for converting a point-to-point multimedia call to a bridged multimedia call. See *Bruno*, Abstract. As *Bruno* states, a point-to-point call is an exchange of data between two users or participants. See,

*e.g.*, *Bruno* col. 2, lines 64-66. The purpose of *Bruno* is to address problems specifically associated with "uninterruptedly accommodating the connection" of a third user's workstation to an "ongoing point-to-point call" between two other users. *Bruno*, col. 2, lines 25-32. For example, in order to include a third user on a call between two other users, "the existing point-to-point multimedia call between [the other two users] must first be terminated." *Id.*, col. 2, lines 32-34. Such a disruption causes problems and is both inconvenient and inefficient, particularly with respect to the two users on the existing point-to-point call. *See id.* col. 2, lines 37-55. *Bruno* specifically addresses these problems. *See, e.g., id.*, col. 2, lines 55-60. However, with the modifications proposed in the Office Action, the original call in *Bruno* would be a conference call between three or more users. This proposed modification would make *Bruno* inoperable for its intended purpose, because its intended purpose is to convert a point-to-point multimedia call to a bridged multimedia call. In addition, the conversion process of *Bruno* of each embodiment disclosed includes steps specifically associated with a conversion from a point-to-point call, such as reconfiguring the point-to-point call by disconnecting the existing point-to-point configuration. Such steps would not apply if the original call were a multipoint conference call between three or more users. Thus, modifying *Bruno* in the manner suggested in the Office Action would make *Bruno* unsatisfactory for its intended purpose and would change its principle of operation.

In addition, there is no motivation to modify *Bruno* in the manner suggested by the Examiner. The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.<sup>1</sup> According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).<sup>2</sup>

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of the prior art. As indicated above, the Office Action suggests that it would have been obvious to "conduct a conference call between two, three, four, ...n of clients, depending on the number of participants in the conference call." Office Action, page 3. However, the Office Action does not cite any

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<sup>1</sup> Note MPEP 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

<sup>2</sup> See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

portion of the prior art as disclosing transferring a conference call between three or more clients from a first call resource to a second call resource. Furthermore, the Examiner has merely stated that at the time the present invention was made, it would have been obvious for one of ordinary skill in the art to make the proposed modification of *Bruno*. However, even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness. *See In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). The Office Action additionally states that "[a]lso bridging the clients in a conference call will provide them with the speed and the convenience." Office Action, page 3. However, this does not provide sufficient motivation with respect to modifying *Bruno*, because even according to *Bruno* users in a conference call are already bridged. Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claim 1, as the Office Action has neither shown the disclosure of each element nor the requisite proof necessary to establish a suggestion or motivation to make the proposed modification.

Furthermore, there is no motivation to make the proposed modification of *Bruno*. As Applicants note above, *Bruno* is solely directed to converting an original existing point-to-point call between two users to a multipoint conference call between three users. If the original call was already a multipoint conference call, then the disclosure of *Bruno* would be pointless, as it merely deals with converting existing point-to-point calls between two users.

Thus, the proposed modification would make *Bruno* unsatisfactory for its intended purpose and would change its principle of operation. In addition, the Office Action has not shown either the disclosure of each element or the required motivation to make the proposed modification. Moreover, as indicated above, no such motivation exists. As failing to rigorously comply with the requirements imposed by the M.P.E.P., the P.T.O. and the Federal Circuit, Applicants respectfully submit that the rejection based on the proposed modification of *Bruno* is improper. Therefore, for at least these reasons, Applicants respectfully submit that Claim 1 is patentable over the cited art used in the rejection and request that the rejection of Claim 1 be withdrawn.

Claims 2, 4 and 8-9 each depends, either directly or indirectly, from Claim 1 and therefore includes each element of Claim 1. Applicants thus respectfully request that the rejections of Claims 2, 4 and 8-9 be withdrawn because, as discussed above, Claim 1 is patentable over the cited art used in the rejections.

In addition, Claim 2 recites "modifying synchronization information in the second mixed media stream to match synchronization information in the first mixed media stream." The Office Action suggests that *Bruno* discloses this element. See Office Action, page 3. However, *Bruno* discloses "reformatting [an] MCU-connected second bearer channel . . . into a format identical to that of the first bearer channel, i.e., to a format for carrying audio, data and a small amount of video information." *Bruno*, col. 6, lines 49-53. "Once reformatting is complete, the information or data bit streams carried by the still-connected point-to-point first bearer channel are duplicated on the newly reformatted second bearer channel now connected between workstation 12a and MCU 36." *Id.*, col. 6, lines 53-57. The mere reformatting of a channel into a format for carrying audio, data and a small amount of video information does not disclose modifying synchronization information. In addition, duplicating a data bit stream carried by one channel on another channel does not disclose modifying synchronization information in a second mixed media stream to match synchronization information in a first mixed media stream. For example, there is no disclosure in *Bruno* that synchronization information is modified. Applicants note that to support a rejection based on disclosure of claim limitations, each and every limitation must be found in a reference, and "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Thus, for at least these additional reasons, Applicants respectfully submit that Claim 2 is patentable over the cited art used in the rejection and request that the rejection of Claim 2 be withdrawn.

Moreover, Claim 4 recites "instructing the second call resource to adjust synchronization information in the second mixed media stream." The Office Action suggests that *Bruno* discloses this element in the disclosure of reformatting a second bearer channel into a format identical to that of a first bearer channel. See Office Action, page 4. However,

merely reformatting a bearer channel into a format identical to another channel does not provide the necessary disclosure of instructing a second call resource to adjust synchronization information in a second mixed media stream. Thus, for at least these additional reasons, Applicants respectfully submit that Claim 4 is patentable over the cited art used in the rejection and request that the rejection of Claim 4 be withdrawn.

**Section 103 Rejections - Bruno-Casper/Logston/Roy/Biggs/Wu**

The Examiner rejects Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Bruno* in view of U.S. Patent No. 4,477,895 issued to Casper et al. ("*Casper*"). The Examiner rejects Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Bruno* in view of U.S. Patent No. 5,467,342 issued to Logston et al. ("*Logston*"). The Examiner rejects Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Bruno* in view of U.S. Patent No. 6,081,513 issued to Roy ("*Roy*"). The Examiner rejects Claims 7 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Bruno* in view of U.S. Patent No. 5,625,407 issued to Biggs et al. ("*Biggs*"). The Examiner rejects Claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Bruno* in view of *Biggs* and in further view of U.S. Patent No. 6,275,575 issued to Wu ("*Wu*"). Applicants respectfully traverse these rejections.

Claims 3 and 5-7 each depends, either directly or indirectly, from Claim 1 and therefore includes each element of Claim 1. Applicants thus respectfully request that the rejections of Claims 3 and 5-7 be withdrawn because, as discussed above, Claim 1 is patentable over the cited art used in the rejections.

Claim 10 is directed to a communication system comprising three or more clients operable to coupled to a packet-based network and operable to initiate or join a conference call, a first call resource, a second call resource and a media gateway operable to transfer the conference call from the first call resource to the second call resource without suspending communication of a plurality of mixed media streams received by the clients. The Office Action applies *Bruno* in a similar manner as discussed above with respect to Claim 1 in rejecting Claim 10. Therefore, for at least the reasons discussed above with respect to Claim

1, Applicants respectfully submit that Claim 10 is patentable over the cited art used in the rejections and request that the rejection of Claim 10 be withdrawn.

Claims 19 and 20 each depends, either directly or indirectly, from Claim 10 and therefore includes each element of Claim 10. Applicants thus respectfully request that the rejections of Claims 19 and 20 be withdrawn because, as discussed above, Claim 10 is patentable over the cited art used in the rejections.

**Other Claims**

The Examiner rejects Claims 11-18 for reasons analogous to those presented with respect to Claims 2-9. The Examiner rejects Claims 22-29 for reasons analogous to those presented with respect to Claims 2-9. The Examiner rejects Claims 30-38 for reasons analogous to those presented with respect to Claims 1-9. The Examiner rejects Claims 39 and 40 for reasons analogous to those presented with respect to Claims 1 and 2. Applicants respectfully traverse these rejections.

As discussed above, Applicants respectfully submit that Claims 1-9 are patentable over the cited art used in the rejections. Therefore, for at least these reasons, Applicants respectfully submit that Claim 11-18, 22-29, 30-38 and 39-40 are patentable over the cited art used in the rejections and request that the rejections of Claims 11-18, 22-29, 30-38 and 39-40 be withdrawn.

**CONCLUSIONS**

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fees are due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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